



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,544	07/25/2000	Edmund A. Hebert	20002.0067	6950

23517 7590 07/16/2003

SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K STREET, NW
BOX IP
WASHINGTON, DC 20007

EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
----------	--------------

1732

12

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

9733428

AS12

Office Action Summary

Application No.

09/625,544

Applicant(s)

HEBERT ET AL.

Examiner

EDMUND H LEE

Art Unit

1732

-- Th MAILING DATE of this communication app ars on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other:

DETAILED ACTION

1. The US patents listed on the IDS filed 4/21/03 has been considered and initialed on the PTO-1449. The foreign references and publication (other documents), however, has not been considered because copies were neither filed with the IDS nor obtainable.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3-11, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan et al (USPN 6015356) as set forth in the previous Office action mailed 12/19/02.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (USPN 6015356) as applied to claim 1 above and further in view of Ward (USPN 3147324) as set forth in the previous Office action mailed 12/19/02.

6. Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (USPN 6015356) in view of Ward (USPN 3147324) as applied to claim 12 above. In regard to claim 20, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30. In regard to claim 21, such is taught by Sullivan et al at col 9, ln 60-col 17, ln 23. In regard to claims 22 and 23, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30. In regard to claim 24, such is taught by Sullivan et al at col 22, ln 65-col 23, ln 41. In regard to claim 25, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30.

7. Claims 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (USPN 6015356) in view of Ward (USPN 3147324). In regard to claim 26, Sullivan et al teach the basic claimed process including a method of forming a golf ball (col 23, lns 35-42; col 25, lns 60-65); forming a golf ball core (col 23, lns 35-42); forming an inner cover layer around the golf ball core with a material having a first shore D hardness, wherein forming the inner cover later comprises compression molding the inner cover material (col 25, lns 60-65); and casting an outer cover layer around the inner cover layer and golf ball core with a thermoset material having a second shore D hardness less than the first (col 23, lns 35-42). However, Sullivan et al does not teach placing the golf ball core in a core holder; gelling the thermoset material in the first mold half; placing the golf ball core into the gelling thermoset material in the first mold half; disengaging the golf ball core from the core holder after a selected period of time;

Art Unit: 1732

placing the golf ball core, while still in the first mold half with the thermoset material against a second mold half having additional thermoset material and mating the two mold halves together; and curing the thermoset material in the mold halves. Ward teaches cast molding a thermosetting polyurethane cover layer onto a golf ball core (figs 1-5); mixing a prepolymer and a curing agent (col 3, lns 65-71; col 4, ln 35-62); filling mold halves with the prepolymer and curing agent (col 3, lns 65-71; col 4, lns 35-62); reacting the prepolymer and curing agent to form a polyurethane outer layer having a thickness (col 3, lns 65-71; col 4, lns 35-62); placing the golf ball core in a core holder (col 3, lns 65-71; col 4, lns 35-62; figs 1-5); gelling the thermoset material in the first mold half (col 3, lns 65-71; col 4, lns 35-62; figs 1-5); placing the golf ball core into the gelling thermoset material in the first mold half (col 3, lns 65-71; col 4, lns 35-62; figs 1-5); disengaging the golf ball core from the core holder after a selected period of time (col 3, lns 65-71; col 4, lns 35-62); placing the golf ball core, while still in the first mold half with the thermoset material against a second mold half having additional thermoset material and mating the two mold halves together (col 3, lns 65-71; col 4, lns 35-62; figs 1-5); and curing the thermoset material in the mated mold halves (col 3, lns 65-71; col 4, lns 35-62; figs 1-5). Sullivan et al and Ward are analogous because they are both related to using thermoset polyurethane to form an outer cover of a golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cast mold the castable thermosetting polyurethane of Sullivan et al by the process of Ward in order to efficiently mold a precise and accurate cover layer. In regard to claim 27, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30. In

Art Unit: 1732

regard to claim 28, such is taught by Sullivan et al at col 9, ln 60-col 17, ln 23. In regard to claims 29 and 30, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30. In regard to claim 31, such is taught by Sullivan et al at col 22, ln 65-col 23, ln 41. In regard to claim 32, such is taught by Sullivan et al at col 31, ln 30-col 32, ln 30.

8. The declaration filed on 4/21/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Sullivan et al reference.\

9. The declaration is ineffective because the scope of the declaration is not commensurate with the claims. Instead of describing what was conceived and reduced to practice, the declaration merely alleges that the declarant conceived and reduced to practice the subject matter of the claimed invention. In order to satisfy 37 CFR 1.131, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, must have a statement of facts demonstrating the correctness of this conclusion, to be sufficient to satisfy 37 CFR 1.131. See MPEP 715.07.

10. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Sullivan et al reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence fails to support 1) forming an inner cover layer having a first shore D hardness, and 2) casting an outer cover layer having a second shore D hardness less

Art Unit: 1732

than the first shore D hardness. There is no mention in the evidence of a difference in shore D hardness between the inner and outer cover layers.

11. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Sullivan et al reference. The evidence fails to support the molding of a golf ball comprising an inner layer having a first shore D hardness and an outer cover layer having a second shore D hardness that is less than the first shore D hardness.

12. Applicant's arguments filed 4/21/03 have been fully considered but they are not persuasive. Applicant argues that Sullivan et al is no longer available because of the declaration filed 4/21/03. A response to this argument is found in the above paragraphs 7-10.

Applicant argues that Ward does not teach a thickness of less than about 0.05 inches. Sullivan et al teach this limitation at col 31, ln 30-col 32, ln 30. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that it would unlikely to eliminate air bubbles during the operation of Ward because Ward teaches the use of a wound core. Even though Ward does teach the use of a wound core, this aspect was not relied upon in the 35 USC 103 rejections. Sullivan et al, the primary reference, teaches the use of a solid core. Applicant is reminded that the test for obviousness is not whether the features of a

Art Unit: 1732

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Also, applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on **MONDAY-THURSDAY FROM 9AM-4PM.**

Art Unit: 1732

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.


EDMUND H LEE 7/14/03
Primary Examiner
Art Unit 1732

EHL
July 14, 2003